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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,051	10/12/2004	Yukio Nakagawa	1745.1002	6192
21171	7590	09/17/2007		
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER JOY, DAVID J	
			ART UNIT 1774	PAPER NUMBER
			MAIL DATE 09/17/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/511,051

Applicant(s)

NAKAGAWA ET AL.

Examiner

David J. Joy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-11, 24 and 25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-11, 24 and 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 October 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-6, 8-11, 24 and 25 are pending as amended on June 19, 2007, with Claims 7, 12-23 and 26 being cancelled.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Response to Amendments

3. The rejection of Claim 25 under 35 U.S.C. §112, second paragraph, as being indefinite has been withdrawn.

Claim Rejections - 35 USC § 102

4. Claims 1-6, 8-11, 24 and 25 stand rejected under 35 U.S.C. 102(e) as being anticipated by the U.S. Patent of Cremon et al. (6,802,659; hereinafter "Cremon").
5. Cremon teaches a roll of packaging material including a holder, a strip of packaging material wound around the holder and a recording medium provided on the holder. The recording medium electromagnetically records packaging related

information that is readable from the recording medium in a non-contact fashion through a resonance phenomenon of radio waves while the strip is wound around the holder (see Figures 4 and 5; see also Column 6, Lines 59-65; see also Column 7, Lines 48-55). Cremon also teaches that the packaging related information includes packaging conditions, material information, fabrication information and product identification (see Column 5, Lines 40-46; see also Column 8, Lines 7-23). In addition, Cremon teaches that the holder has a hollow core and that the recording medium can be located on an inner surface of the hollow core, including along the outermost periphery of the inner surface (see Figures 4 and 5; see also Column 7, Lines 56-62).

6. Cremon teaches that the roll of packaging material with a hollow core having an inner surface and an outer surface, a strip of packaging material wound around the outer surface of the hollow core and a recording medium on the inner surface of the hollow core such that the recording medium is readable in a contact fashion while the strip is wound around the hollow core (see Figures 4 and 5; see also Column 6, Lines 59-65; see also Column 7, Lines 40-55). Cremon recites that the reader is integrated into the roll of material (i.e., on a support onto which the hollow core is placed) and that the reader reads the recording medium electronically, but there is nothing taught which does not permit the fact that the internally integrated reader and the internally

positioned recording medium would not come into contact with one another while the roll of material is in motion.

7. Cremon teaches that the roll of packaging material is supportable by a support shaft with the roll having a hollow core with an inner surface and a strip of packaging material wound around the hollow core and a recording medium provided on the inner surface of the hollow core. The recording medium has packaging related information that is readable from the recording medium in a non-contact fashion through a resonance phenomenon of radio waves while the strip is wound around the holder (see Figures 4 and 5; see also Column 6, Lines 59-65; see also Column 7, Lines 48-55; see also Column 8, Lines 7-31). As for the claimed limitations that support shaft have a recording device provided thereon, and that it be on an outer surface of the support shaft, these limitations are deemed as being directed to a possible future use for the roll of packaging material. The limitations actually relate more so to features that an apparatus onto which the roll of packaging could be loaded then to the claimed limitations of the roll itself. As Cremon teaches that the roll has all of the claimed limitations in the instant application, and that the roll is supportable by a support shaft, it follows that the teachings of Cremon anticipate the support limitations as well.

8. In Claims 2, 5 and 6, the recitation of such phrases as “for packaging the product using said strip of packaging material” (Claim 2) does not positively recite any definite structure over that which is taught by the Cremon patent. Applicant has simply recited a condition for packaging the product, which merely refers to the intended use of the recording medium. Furthermore, Applicant has not positively recited a *product* but only a *material* that could potentially be used *in packaging a product* which defines nothing structurally distinct over that of the packing material as taught by Cremon.

Response to Arguments

9. Applicant's arguments filed on June 19, 2007 have been fully considered but they are not persuasive.

10. Applicant argues that Cremon is directed to a roll of *printing paper* for use by a *printer*. However, Cremon is clearly drawn to programmable devices and materials therefor (see Title of patent). In addition, Cremon recites that it is directed to an *apparatus for reprogramming a programmable product* and that that programmable product *includes memory for storing product operation information* and that the programmable nature of the apparatus employs *data stored on an RFID tag* (see Abstract). Cremon goes further to teach that the data sets the configurable operating parameters and that the

data configures the products features and options as desired by the specific user (*Id.*).

Applicant's argument that Cremon only teaches a printer is incorrect, as a printer is merely one embodiment that the reference discusses; Cremon also discusses material packing with regard to the apparatus taught therein.

11. Applicant further argues that Cremon does not disclose a roll of packaging material that is attachable to a bag forming machine which forms bags in accordance with the read packaging related information as recited in the claims of the instant application. Cremon teaches a roll of paper that is outfitted with an RFID tag, and that that tag can be encoded with data that configures the products features and options. It follows that paper can be used as a packaging material, and it is logical that a roll of paper material can be used to form a package, be it a bag, an envelope, a box, or whatever. Furthermore, it would not take a person skilled in the art to reach that conclusion, though a person having ordinary skill in the art would have been able to conclude that a roll of paper can be used as a packaging material to make packages.

12. With regard to Applicant's argument that the claims of the instant application recite "a roll of packaging material that is attachable to a bag forming machine which forms bags in accordance with the read packaging related information", the claim

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language does not distinctly claim anything structurally or patentably distinct over that which is taught in Cremon. The claim merely recites that the roll is either *attachable* or *supportable*, which means that it is possible that it could be attached to a machine, or that a machine could support the roll. There is nothing distinctly claimed that structurally explains how the roll is attached to and/or supported by a machine. Mere recitation of functional language or language as to an apparatus' intended use does not patentably distinguish the application over the prior art.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

14. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date

of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Joy whose telephone number is (571) 272-9056. The examiner can normally be reached on Monday - Friday, 9:00 AM - 5:00 PM EDT.

16. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton I. Cano can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DJJ
08/23/2007



MILTON I. CANO
SUPERVISORY PATENT EXAMINER